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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---------------------------|--|
| Proceeding | 91212024 |
| Party | Defendant Brooks Entertainment Inc. |
| Correspondence Address | RICHARD B JEFFERSON METAL LAW GROUP LLP 5757 WILSHIRE BLVD PH3 LOS ANGELES, CA 90036 UNITED STATES rjefferson@metallawgroup.com |
| Submission | Motion for Summary Judgment |
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| Date | 10/01/2014 |
| Attachments | TTAB_ApplicantMotionForSummaryJudgment (91212024).pdf(73837 bytes) TTAB_ApplicantMemorandum in Support MSJ (91212024).pdf(324258 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Opposition No.: 91212024

In the Matter of Application
Serial No. 85/551,808

Filed on: February 24, 2012

Published in the Official Gazette on:
July 23, 2013

REPUBLIC TECHNOLOGIES (NA), LLC

Opposer,

v.

BROOKS ENTERTAINMENT, INC.

Applicant.

Opposition No. 91212024

APPLICANT’S MOTION FOR SUMMARY JUDGMENT

Brooks Entertainment, Inc. (Applicant”) hereby moves, pursuant to Rule 56(a), Federal Rules of Civil Procedure, and Rule 2.127 of the Trademark Rules of Practice, for summary judgment in its favor.

Republic Technologies (“Opposer”) has alleged in this proceeding that Applicant’s word and design mark (“Applicant’s Design Mark”) is not entitled to register

with the United States Patent and Trademark Office (“USPTO”) based on its claim of a likelihood of confusion with Opposer’s registered “Job” marks (“Opposer’s Marks”).¹

Applicant sets forth in its accompanying memorandum that Applicant’s Design Mark and Opposer’s Marks are sufficiently dissimilar, even if the Board views Opposer’s facts in the most favorable light. Accordingly, there is no genuine dispute as to any material fact in this proceeding, and, as a matter of law, there is no likelihood of confusion pursuant to Section 2(d) of the Lanham Act, U.S.C. § 1052(d). Summary judgment should be entered in favor of Applicant and this proceeding should be dismissed in its entirety.

In further support of its motion, Applicant submits its Memorandum in Support of Summary Judgment and related record material, and relies on the pleadings of record in this proceeding to date.

WHEREFORE, Brooks Entertainment, Inc. respectfully requests that this Board grant its Motion for Summary Judgment in this matter pursuant to Federal Rules of Civil Procedure 56(a) and 37 C.F.R. § 2.127.

Dated: October 1, 2014

Respectfully submitted,

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“Applicant”

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¹ Brooks Entertainment, Inc. files this motion simultaneously, and in connection with its Motion To Amend Application, which disposes of the two other grounds for its opposition.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **APPLICANT'S MOTION FOR SUMMARY JUDGMENT** was served via U.S. Mail, postage prepaid, on this 1st day of October 2014, upon the attorney of record for Opposer:

Antony J. McShane
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2 North LaSalle Street, Suite 1700
Chicago, Illinois 60602

By: /Richard B. Jefferson/
Richard B. Jefferson

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**MEMORANDUM IN SUPPORT OF
APPLICANT’S MOTION FOR SUMMARY JUDGMENT**

Brooks Entertainment, Inc. (Applicant”) seeks registration of its word and design mark (referred to hereinafter as “Applicant’s Design Mark”). Opposer alleges that Applicant’s Design Mark is not entitled to register with the United States Patent and Trademark Office (“USPTO”) based on Opposer’s claim of a likelihood of confusion with its registered JOB marks (“Opposer’s Marks”).¹

¹ Brooks Entertainment, Inc. files this Motion for Summary Judgment in connection with its simultaneously filed Motion To Amend Application, which is intended to dispose of Opposer’s two newest grounds for its opposition, as stated in Opposer’s Amended Notice of Opposition.

Applicant's Design Mark and Opposer's Marks are sufficiently dissimilar, even when the Board views Opposer's facts in the most favorable light. Accordingly, there is no genuine dispute as to any material fact in this proceeding, and, as a matter of law, there is no likelihood of confusion pursuant to Section 2(d) of the Lanham Act, U.S.C. § 1052(d).

I. INTRODUCTION

Applicant is an active California corporation that has been in business since July 2002. In 2011, Applicant began selling cigars that embodied Applicant's Design Mark, to businesses located in the Dominican Republic and the United States. Applicant filed a word and design trademark application for Applicant's Design Mark with the United States Patent and Trademark Office ("USPTO") on February 24, 2012, in International Class 034 for "cigars". Applicant's Design Mark application was published on July 23, 2013, in the *Official Gazette*.

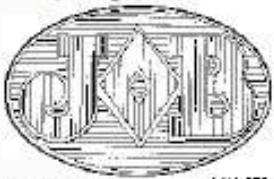


II. UNDISPUTED FACTS

The following are undisputed facts:

- Opposer filed a Notice of Opposition to commence this opposition proceeding on August 14, 2013, which was later amended (the "Amended Notice").
- Applicant's Design Mark appears below:



- Opposer owns and maintains the following USPTO registrations for Opposer's Marks:

| Mark | Registration No. | Registration Date | Goods and Services |
|---|------------------|-------------------|--|
| JOB | 073,124 | March 16, 1909 | cigarette papers |
| JOB (Design)  | 1,341,384 | June 11, 1985 | cigarette papers |
| JOB (Design)  | 2,422,747 | January 23, 2001 | cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes |
| JOB | 2,420,646 | January 16, 2001 | cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes |
| JOB (Design)  | 2,432,868 | March 6, 2001 | cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes |

See Amended Notice ¶ 5

- Opposer claims that Applicant's Design Mark is likely to cause confusion with Opposer's Marks. See Amended Notice ¶ 13

III. STATEMENT OF LAW AND ARGUMENT

A. Legal Standard For Summary Judgment

Summary judgment is proper only where "there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a).











B. There Is No Likelihood of Confusion Between Opposer's Mark and Applicant's Mark As A Matter Of Law

While a determination of whether a likelihood of confusion exists is made by evaluating and balancing the *du Pont* evidentiary factors shown to be applicable to a particular case, as noted in the *du Pont* decision itself, different factors may play a dominant role in any particular case. In re E.I. du Pont de Nemours & Co., 476 f.2d 1357, 1361 (CCPA 1973).

It is well-established that a single *du Pont* factor may be dispositive in a likelihood of confusion analysis, and that where the marks are sufficiently dissimilar, there may be no likelihood of confusion despite the presence of overlapping goods and trade channels. Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373, 1375, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998); Kellogg Co. v. Pack'Em Enterprises, Inc. 951 F.2d 330, 333, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (The Court stated "We know of no reason why, in a particular case, a single du Pont factor may not be dispositive", found the marks FROOTEE ICE and FROOT LOOPS to be dissimilar, and held dispositive); Keebler Co. v. Murray Bakery Prod., 866 F.2d 1386 (Fed. Cir. 1989) (dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES held dispositive); Sears Mtg. Corp. v. Northeast Savings F.A., 24 USPQ2d 1227 (TTAB 1992) (dissimilarity of the marks APPROVAL PLUS and APPROVAL FIRST held dispositive); and Pure Gold, Inc.. v. Syntex (U.S.A.), Inc., 221 USPQ 151 (TTAB 1983); aff'd, 222 USPQ 741 (Fed. Cir. 1984) (dissimilarity of the goods held dispositive).

First, Applicant's Design Mark application specifies only one good, cigars. The goods descriptions in the registrations for Opposer's Marks do not list cigars, so the marks clearly do not overlap on their face; however, whether the goods overlap in theory is actually a moot point. Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); Octocom Systems, Inc. v. Houston Computers Services, Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Here, as in Kellogg Co., the dissimilarity of the marks alone is dispositive of the Section 2(d) claim, even where the party's respective goods potentially overlap. Applicant's Design Mark differs substantially from Opposer's Marks. The table on the following page takes a closer look at the elements of the marks at issue.

|  | <table><tr><th>Mark</th><th>Registration No.</th><th>Registration Date</th><th>Goods and Services</th></tr><tr><td>JOB</td><td>073,124</td><td>March 16, 1909</td><td>cigarette papers</td></tr><tr><td>JOB (Design) </td><td>1,341,384</td><td>June 11, 1985</td><td>cigarette papers</td></tr><tr><td>JOB (Design) </td><td>2,422,747</td><td>January 23, 2001</td><td>cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes</td></tr><tr><td>JOB</td><td>2,430,646</td><td>January 16, 2001</td><td>cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes</td></tr><tr><td>JOB (Design) </td><td>2,432,868</td><td>March 6, 2001</td><td>cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes</td></tr></table> | Mark | Registration No. | Registration Date | Goods and Services | JOB | 073,124 | March 16, 1909 | cigarette papers | JOB (Design)  | 1,341,384 | June 11, 1985 | cigarette papers | JOB (Design)  | 2,422,747 | January 23, 2001 | cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes | JOB | 2,430,646 | January 16, 2001 | cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes | JOB (Design)  | 2,432,868 | March 6, 2001 | cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes |
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| ELEMENTS² | IDENTICAL OR SIMILAR ELEMENTS? | | | | | | | | | | | | | | | | | | | | | | | | |
| <i>a circular design</i> | No | | | | | | | | | | | | | | | | | | | | | | | | |
| <i>floral design around the inside</i> | No | | | | | | | | | | | | | | | | | | | | | | | | |
| <i>a crown at the top</i> | No | | | | | | | | | | | | | | | | | | | | | | | | |
| <i>a circular opening at the center</i> | No | | | | | | | | | | | | | | | | | | | | | | | | |
| <i>tobacco leaves in the background</i> | No | | | | | | | | | | | | | | | | | | | | | | | | |
| <i>a crown above the leaves</i> | No | | | | | | | | | | | | | | | | | | | | | | | | |
| <i>the text “S.O.B.</i> | The letter “B”; Possibly the letter “O”, however Opposer uses a diamond to represent the letter “O” so it is not identical | | | | | | | | | | | | | | | | | | | | | | | | |
| <i>a banner across the lower front.</i> | No | | | | | | | | | | | | | | | | | | | | | | | | |

It is unequivocally clear that, aside from both marks using versions of one or two of the same the letters, none of the elements in Applicant's Design Mark are contained in Opposer's Marks. Furthermore, Applicant uses letters as an acronym (S.O.B.) as opposed to Opposer's word element "Job" so there is also a phonetic difference in the marks. These visual and phonetic distinctions result in vastly different overall commercial impressions. Based on this indisputable fact, there cannot possibly be a likelihood of confusion. The differences between the marks are arguably greater than those in the Kellogg Co., Keebler Co., Sears Mtg. Corp. and Pure Gold, Inc. cases cited above, where

² Applicant's full mark description is as follows: "The mark consists of a circular design with floral design around the inside and a crown at the top, a circular opening at the center with tobacco leaves in the background and a crown above the leaves, and the text "S.O.B." written on a banner across the lower front."

the Courts held that the dissimilarity of the marks alone was dispositive and, thus, there was no likelihood of confusion as a matter of law.

Furthermore, as in the cases cited above, there is no evidence that Opposer may offer at trial that supports a contrary position. Opposer consistently bolsters about its consistent use of its Job marks throughout the years, so it is undisputed that Opposer's mark will not change. See Amended Notice ¶¶ 1 – 6. There are no facts in dispute. Opposer cannot change that the respective marks are significantly different and that, as a matter of law, there is not a likelihood of confusion. Even if Opposer can establish disputed facts with respect to other of the *du Pont* factors, the differences exposed herein will continue to be undisputed.

IV. CONCLUSION

Opposer's primary argument is that both party's marks are used in connection with "smokers articles" making them similar. Applicant understands that actual confusion is an unattainable standard to reach so it has not taken that position. Whether or not cigars and cigarettes overlap is not relevant in this particular matter. There is no visual or aural similarity in the party's respective marks so there is no likelihood of confusion.

Applicant has shown that there is no genuine dispute as to any material fact regarding the dissimilarity of Opposer's Marks and Applicant's Design Mark, even when the Board views Opposer's facts in the most favorable light. Opposer's Marks are so vastly different that as a matter of law, there cannot be a likelihood of confusion.

Accordingly, there is no genuine dispute as to any material fact in this proceeding, and, as a matter of law, there is no likelihood of confusion pursuant to Section 2(d) of the Lanham Act, U.S.C. § 1052(d). As such, Applicant respectfully requests that the Board grant summary judgment in Applicant's favor, and dismiss the proceeding.

Dated: October 1, 2014

Respectfully submitted,

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Attorneys for Brooks Entertainment, Inc.,
“Applicant”

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